

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 74

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ORVILLE RAY HOLBROOKS

Junior Party,
(Application Nos. 09/940,837)

v.

PAUL BACCHI and PAUL S. FILIPSKI

Senior Party
(Patent No. 6,256,555)

Patent Interference No. 105,028

Before URYNOWICZ, SCHAFER and LEE, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

DECISION ON PRELIMINARY MOTIONS AND FINAL JUDGMENT

Only the party Bacchi et al. (Bacchi) filed preliminary motions in this proceeding. The motions are opposed by Holbrooks.

Preliminary Matter

I.

In its oppositions to Bacchi Motions 3-7, Holbrooks requests that each of the motions be dismissed because they violate Standing Order § 28 requiring that motions be limited to 25

pages. At page 8 of its opposition to Motion 3, Holbrooks contends that all of the motions,

move the Board to find claims 17-23 and/or 26-27 to be unpatentable under 35 USC § 112(1) and invalid as anticipated under 35 USC § 102(b) for the [sic] substantially the same reasons, in regard to substantially the same terms and features alleged to be unsupported by the specification, and based on substantially the same alleged facts violates the page limitation set forth in the Standing Order.

Holbrooks' request is denied. In this decision, we address only Motion 3 of Bacchi and this paper is not more than 25 pages long.

Furthermore, even if we considered it advisable to address all the issues in Motions 3-7 on the merits, we would not grant Holbrooks' request. We do not agree with the junior party that these motions are based on "substantially the same reasons." First of all, Motions 3-5 and 7, and Motion 6, are based on different statutory grounds. Motions 3-5 and 7 are based on the first paragraph of 35 U.S.C. § 112, whereas Motion 6 is based on the second paragraph of the statute. Furthermore, even where the statutory ground in the motions is the same (e.g., Motions 3-5 and 7), different groupings of claims are involved, and the arguments in the motions relate to different claim limitations. Compare the different groupings of claims in the three groups comprising Motion 3, Motions 4 and 5, and Motion 7.

Bacchi Preliminary Motion 3

Bacchi moves for judgment against Holbrooks pursuant to 37 C.F.R. § 1.633(a) on the ground that all of Holbrooks' corresponding claims are unpatentable to Holbrooks for failure to

meet the written description requirements of 35 U.S.C. § 112, first paragraph, and as anticipated under 35 U.S.C. § 102(b).

Bacchi asserts that Holbrooks' sole independent claims 17 and 26 require a distal rest pad with a "pad portion for supporting" a wafer. It is urged that Holbrooks relies on surface 42 in finger 105 of Figure 2b to support a pad portion for supporting a wafer. Bacchi argues that Holbrooks does not explicitly describe or illustrate that surface 42 supports a wafer, and that such support is not inherent. Bacchi submits that Holbrooks' most relevant disclosure is that groove 126 having surface 42 holds the wafer by gripping or grasping it. Referring to identical sketches in the upper-right portions of pages 8 and 11 of its motion, Bacchi argues that Holbrooks' groove -- which is described by Holbrooks as small -- can grip the wafer without the wafer contacting lower surface 42. Thus, Holbrooks' actual disclosure does not necessitate that Holbrooks' surface 42, its alleged pad portion, supports the peripheral edge of the wafer. Reliance is had on the Expert Declaration of Dr. John Davies (Exhibit 1025, paragraphs E12-E16) to the effect that the wafer can be held, grasped, or gripped by the groove without being supported, or even contacted, by surface 42. The position is taken that Holbrooks is not entitled to rely on its amendment to its disclosure of June 2002, to the extent that it adds a written description which supports the recitation of a "pad portion for supporting" the wafer.

Bacchi also argues that the involved application does not receive priority from any earlier Holbrooks application because the claimed "pad portion for supporting" is also absent from the disclosures of Holbrooks' earlier applications. Accordingly, the effective filing date of Holbrooks' involved application is its actual filing date, August 28, 2001, and the involved

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application is anticipated by Bacchi's PCT Publication WO 00/33359, which was published June 8, 2000.

Holbrooks opposes by arguing that rest pad 24 of Figure 4 of Bacchi's involved patent is the same as, or equivalent to, the Holbrooks finger 105 shown in its Figures 1 and 2, and operates in the same manner. Holbrooks submits that one skilled in the art would recognize that the profile of its finger 105 or 205 (Figure 9) and the post 103 or 203, with a wafer being held, would look as shown in Attachment B to its opposition, and not as represented in the Bacchi motion at pages 8, 10 or 11.

The junior party argues to the effect that its claims were examined by a primary examiner and were ultimately found to comply with the requirements of 35 U.S.C. § 112, first paragraph. It is urged that once an examiner accepts the sufficiency of an interfering party's specification that party has no further obligation to prove, by extrinsic evidence that the specification was enabling. Fiers v. Revel, 984 F.2d 1164, 1172, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993).

Holbrooks submits that the Declaration of Dr. John Davies should not be considered because it is testimony to support a preliminary motion and was submitted without obtaining authorization under 37 CFR § 1.639(c). It is urged that Dr. Davies is not qualified to provide his opinions because he has experience far in excess of that of one of ordinary skill in the art.

Lastly, it is urged to the effect that because Bacchi's motion has no merit with respect to the issue of written disclosure, involved Holbrooks Application No. 09/940,837 (Application 4/4) is entitled to benefit of its three parent applications, and the WO 00/33359 application published June 8, 2000 is not prior art to it.¹

¹ The three parent applications are referred to by the parties as Application 3/4, Application 2/4, and Application 1/4.

Bacchi's Motion 3 is granted because Holbrooks has no written description under 35 U.S.C. § 112, first paragraph, of a pad portion for supporting the peripheral edge of a specimen or a wafer. It is apparent that Bacchi has established that Holbrooks' specification does not set forth the language of the claims in identical or substantially identical words. Bacchi has also shown that the drawings do not illustrate structure that specifically meets the language of the claims. However, this alone is not fatal to Holbrooks because the written description requirement of 35 U.S.C. § 112 asks no more than whether the disclosure as originally filed would reasonably convey to an ordinary artisan that the inventor was in possession of the claimed subject matter. Ralston Purina Co. v. Far-Mar Co., Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed Cir. 1985). Nevertheless, we find that Holbrooks' disclosure does not satisfy this requirement.

The junior party's position that the profile of its finger 105 or 205 and the post 103 and 203, with a wafer being held, would look as shown in Attachment B to its opposition has not been shown to have any basis in fact in its original disclosure. Holbrooks has not shown how its disclosure describes or illustrates a finger or post with 1) an upper portion narrower than the lower portion or 2) a wedge-shaped space of sufficient size to permit a wafer to be supported on the lower surface (rest pad) of the groove defining the wedge-shaped space. Holbrooks has not directed our attention to any part of its disclosure that would reasonably convey to an ordinary artisan that it was in possession of the subject matter illustrated in its Attachment B.

We agree with Bacchi that Holbrooks' surface 42 does not inherently support a wafer. A reasonably depicted side view of a finger or post as disclosed by Holbrooks in Figure 2b is illustrated at page 8, and again at page 11, of Bacchi's Motion 3. As shown in Holbrooks'

Figure 2b, the width of the side of the finger is substantially uniform, not recessed at one end from the location of the notch or groove 126. In the embodiments presented in the Holbrooks application, the plurality of fingers or posts grip or grasp the wafer, without a lower surface 42 of the grooves being disclosed as a pad portion for supporting the wafer. It is not sufficient for inherency that a person following the disclosure of Holbrooks might obtain the result set forth in the claims, it must invariably happen. Scaltech Inc. v. Retec/Tetra, LLC., 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. Cir. 1999); Snitzer v. Etzel, 531 F.2d 1062, 189 USPQ 415 (CCPA 1976). Bacchi has established that a person following Holbrooks' disclosure would not invariably obtain the subject matter set forth in the claims of a pad portion for supporting the edge of a specimen or wafer.

The fact that the primary examiner ultimately found that Holbrooks' specification complied with the requirements of 35 U.S.C. § 112, first paragraph, is not controlling as to the written description issued raised by Bacchi. The Board is not bound by a primary examiner's decision on an issue of patentability because 37 CFR § 1.633(a) provides for motions for judgment against a party by an opponent on the grounds of unpatentability of the party's involved claims. As to the Fiers case, it is not controlling here. Fiers stands for the proposition that once a primary examiner in *ex parte* practice accepts the sufficiency of a specification such as Holbrooks', the inventor has no further burden to prove before the examiner by extrinsic evidence that its application satisfies the written description requirement of 35 U.S.C. § 112, first paragraph. In contrast, this is an *inter partes* proceeding before the Board. Bacchi filed its Motion 3 under 37 CFR § 1.633(a) and challenged Holbrooks' compliance with the written description requirement of the above statute. Whereas that portion of Fiers relied on by

Holbrooks involved a primary examiner's decision in *ex parte* practice, it is simply not controlling here. Failure of a party to fully defend itself against the motion of an opponent in an *inter partes* proceeding such as this does so to its own peril.

We find the Declaration of Dr. John Davies persuasive to the extent it supports Bacchi's position on this issue of whether Holbrooks satisfies the written description requirement of 35 U.S.C. § 112, first paragraph. Holbrooks did not attack the declaration specifically as to content. The junior party's argument that the declaration should not be considered because it was submitted without obtaining authorization under 37 CFR § 1.639(c) is not persuasive because § 1.639(a) of the rule authorizes the filing of proof of any material fact alleged in a motion and § 1.639(b) authorizes the filing of proof in the form of affidavits. Holbrooks' only other argument with respect to the declaration -- that Dr. Davies has experience far in excess of that of one of ordinary skill in the art -- is also not persuasive because it is established that an expert witness who has more than ordinary skill in the art is qualified to provide his opinions concerning matters of what would be obvious to persons of lesser skill than his own. Moore v. Westbar Corp., 701 F.2d 1247, 1253, 217 USPQ 684, 689 (7th Cir. 1983).

Whereas Holbrooks' involved claims are unpatentable to it under 35 U.S.C. § 112, first paragraph, Bacchi's position that the claims are unpatentable to Holbrooks under 35 U.S.C. § 102(b) is dismissed as moot.

Bacchi's Motions 1, 2 and 4-7

These motions are dismissed as moot in view of our findings, above, with respect to dispositive Bacchi Motion 3.

Holbrooks' Status

This interference was provoked by Holbrooks based upon claims which have been held not to be supported by a written description. Holbrooks has not filed a motion under 37 CFR § 1.633(c)(2) pursuant to § 1.633(i) to add claims to the Holbrooks application that were both supported by the Holbrooks application and interfere with Bacchi's claims. Holbrooks was provided an opportunity to file such a responsive motion. See Paper 17, page 8, Time Period 2. Under the circumstances of this case, Holbrooks lacks standing to prosecute this interference. The proceedings of an interference are to be conducted "to secure the just, speedy, and inexpensive determination of every interference." 37 CFR § 1.601. It would be inconsistent with this goal to continue an interference where the provoking party does not have written descriptive support for that party's involved claims. It is, therefore, appropriate to terminate the interference with a final judgment at this time.

Judgment

It is

ORDERED that judgment as to the subject matter of the count is herein entered against junior party Orville Holbrooks;

FURTHER ORDERED that junior party Orville Holbrooks is not entitled to his application claims 17-23, 26 and 27 which correspond to the count;

FURTHER ORDERED that judgment as to the subject matter of the count is herein entered for senior party Paul Bacchi and Paul S. Filipiski;

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FURTHER ORDERED that on the present record the senior party Paul Bacchi and Paul S. Filipski are entitled to their patent claims 1-5, 8, 9, 16 and 17 which correspond to the count;

FURTHER ORDERED that a copy of this paper will be entered in the involved application or patent file of the respective parties; and

FURTHER ORDERED that if there is an agreement between the parties facilitating or leading toward the termination of this interference, the parties' attention is directed to 35 U.S.C. § 1.135(c) and 37 CFR § 1.661.

STANLEY M. URYNOWICZ, JR.)
Administrative Patent Judge)
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RICHARD E. SCHAFER)
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JAMESON LEE)
Administrative Patent Judge)

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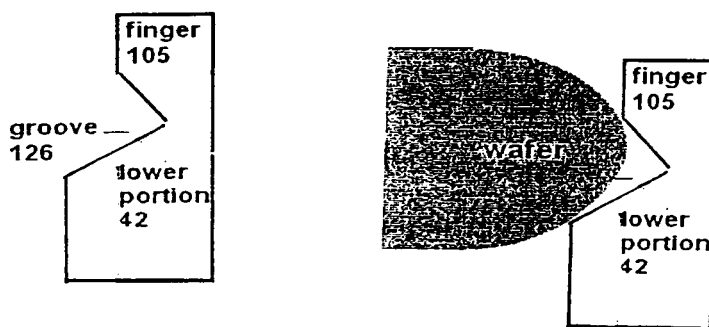
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Additional Views:

LEE and SCHAFER, Administrative Patent Judges.

LEE, Administrative Patent Judge.

The parts of Holbrooks' Attachment B showing the purported profiles of its finger 105 or 205 are reproduced below:



If the profile of Holbrooks' disclosed fingers really were as shown above, it may be an effective rebuttal to Bacchi's charge of lack of written description. However, the off-set or recessed concept of these illustrations does not stem from any referenced disclosure in the specification but is evidently created for the purpose of opposing Bacchi's motion. It is disturbing that Holbrooks would present and rely on these illustrations as though they are what the specification describes, without citing any part of the specification and without any explanation.

What Holbrooks said about these illustrations are: (1) "A side view of the Holbrooks finger within the scope of the Holbrooks applications is shown in Attachment B"; and (2) "One skilled in the art would recognize that the profile of the Holbrooks finger 105 or 205 and the post

103 or 203, with wafer being held, would look as shown in Attachment B and not as represented in the Bacchi motion at page 8, 10 or 11.” The second statement merely reflects wishful thinking that is not supported by evidence. The first statement, however, in the absence of any explanation, is a misrepresentation. It refers to “the Holbrooks finger within the scope of the Holbrooks application.” In that context, use of the definite article “the” in the first instance implies that Holbrooks is referring to a specifically described embodiment and not some non-described embodiment which may happen to fall within the scope of what is claimed. Also, the statement refers to “within the scope of the Holbrooks application” and not “within the scope of a Holbrooks claim,” which again implies specific description in the application’s disclosure rather than any non-described embodiment which may happen to fall within the scope of a claim.

In any event, a broad or generic term does not provide written description for all specific embodiments that may fall within the scope of that term. Even assuming that Holbrooks meant to say “a finger structure within the scope of what is claimed,” that does not effectively rebut the charge of lack of written description.

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RICHARD E. SCHAFER)
Administrative Patent Judge)
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